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08/692,084

| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 08/692,084         | 08/08/96    | RODRIGUEZ             | M 1199-1-001-C      |

18M1/0529

EXAMINER  
DUFFY, P

DAVID A JACKSON  
KLAUBER AND JACKSON  
411 HACKENSACK AVENUE  
HACKENSACK NJ 07601

ART UNIT  
1818 6 PAPER NUMBER

DATE MAILED:

05/29/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or ~~three~~ days, ~~which is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- Claim(s) 1 - 19 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims 1 - 19 are subject to restriction or election requirement.

## Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

Art Unit: 1818

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 9-14 and 19, drawn to methods of treating demyelinating diseases and promoting remyelination and therapeutic composition therefore, classified in class 242, subclass 141.1.
  - II. Claims 5-8 and 15-18, drawn to methods of stimulating the proliferation of glial cells, classified in class 435, subclass 375.
2. The inventions are distinct, each from the other because of the following reasons:

The inventions of Group I and Group II are related as methods. The methods are distinct each from the other because they have different goals as evidence by the preambles, require different method steps and have different final outcomes (i.e. treatment of disease versus glial cell proliferation and glial cell transplantation). For example, in Group I the antibody is administered in vivo to promote remyelination or treating demyelinating diseases whereas group II requires the proliferation of glial cells in mixed culture and further transplants the proliferated glial cells. Methods which detect and measure proliferation, would not properly measure remyelination. A search of proliferation would not encompass myelination.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their separate classification, restriction for examination purposes as indicated is proper and in the absence of restriction would place an undue burden on the examiner. Because these inventions are distinct for the reasons given above and the search for the therapeutic use required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Barbara Renda on May 27, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy, Ph.D. whose telephone number is (703) 305-7555. The examiner can normally be reached on Monday-Friday from 6:30 AM to 3:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application should be directed may be submitted to Group 1800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The FAX number for Art Unit 1818 is (703) 308-4242.

Patricia A. Duffy, Ph.D.  
May 28, 1997

*Patricia A. Duffy*  
Patricia A. Duffy, Ph.D.  
Patent Examiner  
Group 1800